

REMARKS

Claims 1-3, 5, 8, 9 and 11-21 remain pending in the application. Claims 1-3, 5, 8, 9, 11-19 and 21 stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over Brugger et al (6,156,419) in view of Malhotra (5,589,277); and Claim 20 stands finally rejected under 35 U.S.C. §103(a) as being unpatentable over Brugger in view of Malhotra (as applied to claims 1-3, 5, 8, 9, 11-19 and 21) and further in view of Floegel et al (US 6,284,339), Uemura et al. (US 6,153,305) or Kasahara et al. (US 6,165,606).

The Examiner has withdrawn her rejection of the claims over Malhotra II.

Claim Rejections - 35 U.S.C. §103(a)

Claims 1-3, 5, 8, 9, 11-19 and 21 have been finally rejected under 35 U.S.C. §103(a) as being unpatentable over Brugger et al (US 6,156,419) in view of Malhotra (US 5,589,277). Applicant respectfully disagrees.

The Examiner states that the difference between the present claimed invention and Brugger is the requirement in the claims that the ink receiving layer contains an aliphatic hydroxycarboxylic acid with more than 2 C atoms. To supply the missing element, the Examiner has cited Malhotra as teaching:

"the inclusion of an additive hydroxy acid, including aliphatic hydroxycarboxylic acids, in an ink jet recording medium to obtain a medium that has rapid ink drying times, that enables precipitation of a dye from the ink, that is useful in a process including microwave drying and that exhibits reduced curl subsequent to being imaged. It would have been obvious to one of ordinary skill in the art to utilize such an additive in the recording layer of the medium of the primary reference in order to obtain the advantages set forth above."

It is well settled that the mere fact that the prior art could be modified to form the invention would not make the modification obvious *unless the prior art suggested the desirability of the modification*. *In re Laskowski*, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

It is submitted that the cited art does not teach or suggest the desirability of modifying the ink receiving layer of Brugger by adding the hydroxy acid of Malhotra to produce an ink receiving layer which has the superior light stability of the present invention.

Malhotra teaches a substrate and at least one compound selected from the group consisting of amino acids, hydroxy acids, polycarboxyl compounds, and mixtures thereof. As the Examiner has pointed out, Malhotra teaches that the use of such materials in an ink jet recording medium provides a medium that has rapid ink drying times that enables precipitation of a dye from the ink, that is useful in a process including microwave drying and that exhibits reduced curl subsequent to being imaged. Significantly, Malhotra neither teaches nor suggests that the inclusion of such materials in an ink receiving layer such as that of Brugger would increase light stability. There is thus no suggestion in Malhotra to combine the references to arrive at the present invention.

Furthermore, Brugger teaches that by adding from 0.04 to 4.2 mole percent of one or more, elements of the rare earth metal series of the periodic system of the elements with atomic numbers 57 to 71 relative to Al_2O_3 to an aluminum oxide/hydroxide an ink jet recording sheet is provided with high ink absorptiveness, high ink absorption rate and excellent image quality. There is no teaching or suggestion in Brugger that by

adding the aluminum oxide/hydroxide containing rare earth metals to a hydroxy acid ink receiving layer of Malhotra one could achieve the superior light fastness of the present invention.

The Examiner asserts that “[t]he suggestion to modify the primary reference is present in the secondary reference which teaches advantages to inclusion of an additive in an ink receiving layer, the additives including acids as instantly claimed.” Applicant submits that this is a mischaracterization of the secondary reference, in that the secondary reference teaches using acids as instantly claimed *as the ink receiving layer and not as an additive in an ink receiving layer*. See, e.g., Malhotra col. 10, lines 43 – 60, and col. 12, lines 7 – 10.

Thus there is no suggestion in the cited art of the desirability of modifying Brugger to obtain the presently claimed invention and the references may not be properly combined. Applicant contends that the Examiner has not made a prima facie case of obviousness and that claims 1 – 3, 5, 8, 9, 11 – 19 and 21 are patentable over the cited references.

Claim Rejection - 35 U.S.C. §103(a)

Claim 20 has been finally rejected under 35 U.S.C. §103(a) as being unpatentable over Brugger in view of Malhotra (as applied to claims 1-3, 5, 8, 9, 11-19 and 21) and further in view of Floegel et al (US 6,284,339), Uemura et al. (US 6,153,305) or Kasahara et al. (6,165,606). Applicant respectfully disagrees.

The Examiner has rejected claim 20 on the same basis as independent claim 1, from which claim 20 directly depends. Applicant contends that in view of the fact that claim

20 incorporates by reference all of the limitations of claim 1, Applicant's argument for the patentability of claim 1 applies to claim 20 as well.

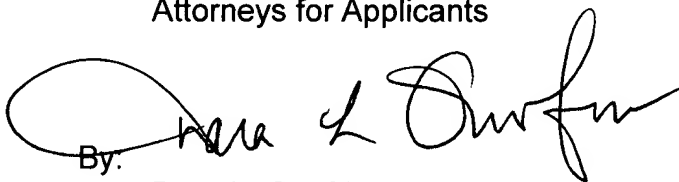
The further references Floegel, Uemura and Kasahara were cited by the Examiner to supply the additional limitations of claim 20, and not to supply any of the limitations for which the Malhotra reference was cited.

Thus, the Examiner having not supplied any further references which would supply the limitations missing from claim 1, applicant submits that the examiner has not made a prima facie case of obviousness and that claim 20 is patentable over the cited references.

Applicant submits that this application is now in condition for allowance. The claims have not been amended and no new matter has been introduced by this Amendment. Reconsideration of this application and allowance of the pending claims are hereby requested, particularly, Claims 1-3, 5, 8, 9 and 11-21.

If a telephone interview would be useful to advance this case, then the Examiner is invited to telephone the undersigned.

Respectfully submitted,
ONOFRIO LAW
Attorneys for Applicants

By. 

Dara L. Onofrio
Reg. No. 34,889
1133 Broadway – Suite 1600
New York, N.Y. 10010
(212) 871-6112 (phone)
(212) 871-6113 (fax)

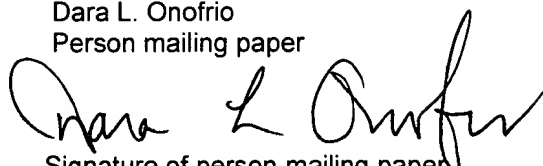
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